

REMARKS

I. General Remarks

Claims 1- 23 remain in the application. Claims 13-17 and 20-23 have been cancelled. New claims 24-32 have been added.

II. Objection Regarding Tables Associated with the Claims

The Examiner requested that the claims be rewritten without the use of tables as follows:

Tables associated with the claims do not maintain the spatial relationships (e.g., columns and rows) of the table elements and preserve the information they convey after have been imaged from the PTO IFW imaging system. Appropriate correction is required.

Non-Final Office Action at 6. Accordingly, claims 13-17 and 20-23 have been cancelled and replaced by new claims 24-32. New claims 24-32 are claims 13-17 and 20-23 rewritten in textual format without resort to the use of tables so as to address the Examiner's objection.

III. Claim Objections

The Examiner requested clarification as to the language of claim 1 as follows:

Claim 1 is objected to because of the following informalities: it appears that limitation "... from **and** unrelated to a specific facility" in claim 1a. should be "... from **an** unrelated ...". Appropriate correction is required.

Non-Final Office Action at 6. Applicant maintains that the use of the conjunction "and" is intended. Accordingly, claim 1 should may equivalently be read as "collecting external data externally generated from *a specific facility* and unrelated to a specific facility." Thus, the conjunction "and" joins the prepositional phrases "generated from" and "unrelated to" to the prepositional phrase "a specific facility."

IV. Prior Art Rejections

Claims 1-10 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. Publication 2003/0115198 issued to Singer *et al.* (hereinafter "Singer"). Claim 11 stand rejected

under 35 U.S.C. § 103(a) as being obvious over Singer in view of U.S. Pat. No. 5,668,735 issued to Dominguez *et al.* (hereinafter “Dominguez”). Claims 12-23 stand rejected under 35 U.S.C. § 103(a) as being obvious over Singer in view of Dominguez and further in view of EPA Document AP-42 and engineering/industry calculations.

Applicant’s 37 C.F.R. § 1.131 affidavit establishes a date of invention before the priority date of Singer as explained below. Applicant traverses each of these rejections on the grounds that Singer should be removed as a basis for rejection based on the 37 C.F.R. § 131 Affidavit submitted herewith. Thus, Singer is no longer effective as prior art as to Applicant’s claims. Accordingly, Applicant respectfully requests removal of the 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a) rejections as to Applicant’s claims.

V. Applicant’s 37 C.F.R. § 1.131 Substitute Affidavit and Accompanying Exhibits

A. The Examiner’s Requests for Additional Information Regarding Conception and Diligence

The attached 37 C.F.R. § 1.131 Substitute Affidavit, along with the evidence provided therein, establishes that the Applicant conceived of the invention prior to the earliest possible priority date of Singer, and used diligence in pursuing the invention until the filing of the current application, resulting in constructive reduction to practice.

In reviewing the prior submitted §1.131 affidavit, the Examiner requested a detailed showing of the correspondence between elements of the claims and the evidence presented as follows:

Applicant does not meet the burden for satisfactory evidence of the fact of prior invention as set forth in MPEP 713.07. In particular, the correspondence between elements of the claims and the evidence presented (i.e. draft Flow Chart) has not been addressed.

Non-Final Office Action at 3. Accordingly, Applicant respectfully submits the requested information with respect to conception of the invention in Section B below.

Additionally, the Examiner requested additional evidence with respect to a showing of diligence as follows:

In terms of due diligence, there are gaps between the documents included in the Declaration *without explanation*. For example, the gap of five months between Document I and Document II, the gap of sixteen months between Document II and Document III, the gap of seven months between Document III and Document IV, etc., all without explanation.

...

An applicant must account for the entire period during which diligence is required.

Non-Final Office Action at 4-5. Accordingly, Applicant respectfully submits the requested information with respect to diligence of the invention in Section B below.

B. Conception: Correspondence Between Claim Elements and Evidence Presented

1. Relevant Dates

Singer was filed on February 4, 2003 but claims priority to U.S. Application No. 09/654,515, filed on September 1, 2000 ("Singer Priority Date"). The Singer Priority Date is less than one year prior to Applicant's May 4, 2001 filing date. Exhibits 1-14 have dates preceding the Singer Priority Date and thus may be used to show conception of the invention. See § 1.131 Affidavit, ¶¶ 7-9.

2. Standard for Showing of Conception

The M.P.E.P. explains the standard for 37 CFR 1.131 affidavits as follows:

The 37 CFR 1.131 affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim (such as a species of a claimed genus), in the sense that the claim as a whole reads on it.

...

Note, however, where the differences between the claimed invention and the disclosure of the reference(s) are so small as to render the claims obvious over the reference(s), an affidavit or declaration under 37 CFR 1.131 is required to show no more than the reference shows. *In re Stryker*, 435 F.2d 1340, 168 USPQ 372 (CCPA 1971). In other

words, where the examiner, in rejecting a claim under 35 U.S.C. 103, has treated a claim limitation as being an obvious feature or modification of the disclosure of the reference(s) relied upon, without citation of a reference which teaches such feature or modification, a 37 CFR 1.131 affidavit or declaration may be sufficient to overcome the rejection even if it does not show such feature or modification.

M.P.E.P. § 715.02. Thus, a sufficient 37 CFR 1.131 affidavit may show either (1) possession of either the whole invention claimed OR (2) something falling within the claim. The attached 37 C.F.R. § 1.131 affidavit does both. In particular, paragraphs 7-9 of the § 1.131 Affidavit distinctly point out the correspondence between the claim elements and the description contained in Exhibit 5.

For the foregoing reasons, and in light of the averments in the Affidavit, accompanied with the evidence of Exhibits 1-14, Singer should be withdrawn as grounds for the various rejections and Claims 1-23.

C. Diligence: An Accounting of the Time Period From Just Before the Filing of Singer to the Constructive Filing of Applicant's Patent Application

The M.P.E.P. explains the relevant period of time for showing diligence as follows:

Under 37 C.F.R. § 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" is not relevant to an affidavit or declaration under 37 CFR 1.131. *See Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947).

M.P.E.P. § 715.07(a). Accordingly, the timeline in the § 1.131 Affidavit accounts for the time period just before the priority date of the prior art reference Singer (i.e. September 1, 2000) and the construction reduction to practice of Applicant's invention (i.e. May 4, 2001, the filing date of Applicant's patent application). *See* § 1.131 Affidavit, ¶¶ 10-12, accompanied by the evidence of Exhibits 15-28. The timeline with accompanying description shows diligence of the inventor towards a constructive reduction to practice by accounting in detail for the activity during this

relevant time period. *See id.* Those skilled in the art will appreciate that the method of the invention is carried out through execution of software. The evidence provided by the Applicant establishes continuous and ongoing efforts to “program” or write the necessary code and software modules to execute the steps of the invention. As such, the evidence establishes the requisite diligence under MPEP § 715.07(a).

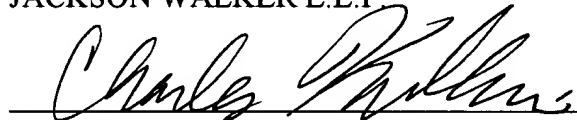
SUMMARY

Authorization is hereby given to charge Deposit Account No. 10-0096 for any deficiency of fees.

This 37 C.F.R. § 1.131 Affidavit is being filed in response to a non-final office action and is therefore considered timely filed in accordance with MPEP § 715.09.

If the Examiner has any other matters which pertain to this Application, the Examiner is encouraged to contact the undersigned to resolve these matters by Examiner's Amendment where possible. A prompt examination and allowance of the pending claims is earnestly solicited.

Respectfully submitted,
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CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited on the date shown below with the United States Postal Service, with sufficient postage as Express Mail Label No., EL978251377US, in an envelope addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450.

Date: January 12, 2007


Renee Treider